



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,543	09/17/2001	Frank A. Barbosa	ORTIZ-1001	3149

7590

03/23/2004

KERMIT D. LOPEZ/LUIS M. ORTIZ
ORTIZ & LOPEZ, PLLC/ PATENR ATTORNEYS
P.O. BOX 4484
ALBUQUERQUE, NM 87196-4484

EXAMINER

RAMAKRISHNAIAH, MELUR

ART UNIT	PAPER NUMBER
----------	--------------

2643

3

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/955,543

Applicant(s)

BARBOSA ET AL.

Examiner

Melur Ramakrishnaiah

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 3, 6, 10, 16, 19, are rejected under 35 U.S.C 102(b) as being anticipated by Montlick (US PAT: 5,561,446).

Regarding claim 1, Montlick discloses a handheld data management device for field assessments, comprising: memory for storing field assessment programs and related data (col. 6 lines 7-14), microprocessor (not shown) for executing filed assessment programs, field assessment software stored within the memory, user interface for enabling a user to interact with the field assessment software (col. 5 lines 36-51), synchronization means for providing data to and retrieving data from remote computing resources (this is implied in as much as the system is in a multi-user

Art Unit: 2643

environment and data can be retrieved from a central computer, col. 4 lines 6-9, col. 12 lines 50-53).

Regarding claim 10, Montlick further discloses a method of conducting a field assessment using a handheld data management device, comprising: providing access to a industry-specific field assessment program module, executing program module to conduct field assessment, providing field specific information required by the program module for the program module to render data from the module in support of field assessment (col. 3 lines 31-46), retrieving data from the handheld data management device in support of field assessment (col. 4 lines 6-9).

Regarding claims 3, 6, 16, 19, Montlick further teaches the following: wireless communication module for providing access to data from remote resource (10, fig. 1) to the device (12, fig. 1, col. 4 lines 12-17), providing two way communication between the remote computing means (10, fig. 1) and handheld data management devices (12, 14, 16, fig. 1) to facilitate real-time access to remote programs, assistance and/or information related to the filed assessment being undertaken by using handheld data management device user, accessing a remote data resource for retrieving data in support of the assessment (col. 4 lines 12-17).

3. Claim 33 is rejected under 35 U.S.C 102(e) as being anticipated by Christensen (US PAT: 6,662,193 B1, filed 6-2-2000).

Regarding claim 33, Christensen discloses a method of utilizing a handheld data management device for inventory management comprising: starting an inventory program from a handheld data management device (230, figs. 2-3), the program used to

Art Unit: 2643

ensure that the proper inventory will be provided prior to undertaking a daily service schedule, identifying service schedule requirements, synchronize the schedule with inventory data accessible by the inventory manager, assessment by the inventory manager of schedule requirements and available inventory, and providing the technician with the inventory availability status based on inventory needs identified in the schedule (col. 6 lines 10-11, lines 26-32, lines 7 lines 59-63, col. 9 lines 12-25, col. 10 lines 34-56).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 4-5, 7, 8, are rejected under 35 U.S.C. 103(a) as being unpatentable over Montlick in view of Alexnander, Jr. (US PAT: 6,083,353, hereinafter Alexnander).

Regarding claims 2, 4, 7, Montlick does not teach the following: positioning module, for providing handheld device location identification.

However, Alexnander discloses handheld portable digital geographic data manger, which teaches the following: positioning module, for providing handheld device location identification (col. 15 lines 23-31).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Montlick's system to provide for the following: positioning module, for providing handheld device location identification as this arrangement would

Art Unit: 2643

provide location information so as to be useful for track the object of interest as taught by Alexander.

Regarding claim 5, Montlick teaches the following: wireless communication module for providing access to data from remote resource (10, fig. 1) to the device (12, fig. 1, col. 4 lines 12-17).

Montlick differs from claim 8 in that he does not teach the following: a positioning module, for providing handheld device location identification.

However, Alexander discloses handheld portable digital geographic data manager, which teaches the following: positioning module, for providing handheld device location identification (col. 15 lines 23-31).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Montlick's system to provide for the following: positioning module, for providing handheld device location identification as this arrangement would provide location information so as to be useful for track the object of interest as taught by Alexander.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montlick in view of Alexander as applied to claim 8 above, and further in view of Brick et al. (US PAT: 6,172,620 B1, hereinafter Brick).

Regarding claim 9, the combination does not teach the following; the program module comprises at least one of: construction industry analysis program, project management program, inventories tracking program, etc.

However, Brick discloses portable data terminal which suggests use of different program modules to satisfy application requirements (col. 1 lines 39-44).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: the program module comprises at least one of: construction industry analysis program, project management program, inventories tracking program, etc, as this arrangement would provide necessary programs to meet application requirements as suggested by Brick , thus enhancing the application capability of the system.

7. Claims 11-15, 17-18, 20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Montlick as in view of Bee et al. (US PAT: 5,990,932, hereinafter Bee).

Regarding claims 11-15, 17-18, 20, Montlick does not teach the following: providing data to a remote resource for analysis, retrieving enhanced data from the remote resource for use in conducting the field assessment, data is provided to a remote resource is a query message from a field assessor to a remote counselor and enhanced data from the remote resource is a response message provided by the remote counselor in response to query message which includes supporting data files, accessing a remote data resource for retrieving data in support of the assessment, third party database accessible over the internet, data is provided to the remote resource in the form of a query message from a field assessor to a remote counselor and enhanced data from the remote resource is a response message provided by the remote counselor in response to the query message.

However, Bee discloses Collaborative shared space which teaches the following: providing data to a remote resource for analysis, retrieving enhanced data from the remote resource for use in conducting the field assessment, data is provided to a remote resource is a query message from a field assessor to a remote counselor and enhanced data from the remote resource is a response message provided by the remote counselor in response to query message which includes supporting data files, accessing a remote data resource for retrieving data in support of the assessment, third party database accessible over the network, data is provided to the remote resource in the form of a query message from a field assessor to a remote counselor and enhanced data from the remote resource is a response message provided by the remote counselor in response to the query message (col. 6 lines 20-47, col. 5 lines 53-67, col. 6 lines 1-12).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Montlick's system to provide for the following: providing data to a remote resource for analysis, retrieving enhanced data from the remote resource for use in conducting the field assessment, data is provided to a remote resource is a query message from a field assessor to a remote counselor and enhanced data from the remote resource is a response message provided by the remote counselor in response to query message which includes supporting data files, accessing a remote data resource for retrieving data in support of the assessment, third party database accessible over the internet, data is provided to the remote resource in the form of a query message from a field assessor to a remote counselor and enhanced

data from the remote resource is a response message provided by the remote counselor in response to the query message as this arrangement would facilitate to make use of services from a specialist at a remote location for rendering services at a local station as taught by Bee.

8. Claims 21-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montlick in view of Bee as applied to claim 10 above, and further in view of Brick.

Regarding claim 21, the combination does not teach the following: the program module comprises at least one of: construction industry analysis program, project management program, inventories tracking program, etc.

However, Brick discloses portable data terminal which suggests use of different program modules to satisfy application requirements (col. 1 lines 39-44).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: the program module comprises at least one of: construction industry analysis program, project management program, inventories tracking program, etc, as this arrangement would provide necessary programs to meet application requirements as suggested by Brick , thus enhancing the application capability of the system.

Regarding claims 22-29, the combination teaches the following: providing data to a remote resource for analysis, data provided to a remote resource is a query message from a field assessor to a remote counselor and enhanced data from the remote resource is a response message provided by the remote counselor in response to the query message, response message includes supporting data files, accessing a remote

Art Unit: 2643

resource for retrieving data in support of the assessment, data resource is a third party database accessible by the internet, providing two-way communication between remote computing means and handheld data management device to facilitate real-time access to remote programs, assistance and/or information related to the field assessment being undertaken by using a handheld data management device user (col. 4 lines 12-17 of '446), data is provided to the remote resource in the form of a query message from a field assessor to a remote counselor and enhanced data from the remote resource is a response message provided by the remote counselor in response to the query message, response message includes supporting data files (col. 6 lines 20-47, col. 5 lines 53-67, col. 6 lines 1-12 of '932)

9. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Christensen in view of Izumi (JP 408055161A).

Regarding claim 34, Christensen does not teach the following: inventory needed and available for the service schedule are reserved through the program to an inventory supplier, wherein needed inventory is taken to service calls.

However, Izumi discloses article ordering system which teaches the following: inventory needed and available for the service schedule are reserved through the program to an inventory supplier, wherein needed inventory is taken to service calls (see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the Christensen's system to provide for the following: inventory needed and available for the service schedule are reserved through the

Art Unit: 2643

program to an inventory supplier, wherein needed inventory is taken to service calls as this arrangement would facilitate efficient management of the business enterprise as taught by Izumi.

10. Claims 35-37, 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al. (US PAT: 5,444, 615) in view of Montlick

Regarding claims 35, 38, Bennett discloses a method of conducting legal investigation using data management device, comprising: starting a legal investigation form, identifying the subject matter for a legal investigation, obtaining guidance regarding performing a complaint legal investigation, receiving investigation data associated with a legal investigation from at least one data management device, analyzing the investigation data, and rendering analysis results (figs. 1-2, col. 5 lines 4-62).

Regarding claims 36-37, 39-40, Bennett further teaches the following: guidance is tailored to requirements of the jurisdiction, communicating the data entered into the data management device (for example 21, figs. 1-2) to a remote resource (43, 63, 91, 92, fig. 1) for analysis (col. 6 lines 3-26), providing legal investigation shortfall information to remote data management device associated with the shortfall, updating and formatting for representation and distribution to plural workers (col. 7 lines 42-68, col. 8 lines 1-6, col. 12 lines 37-40).

Bennett differs from the claimed invention by not teaching handheld data management device.

However, Montlick discloses handheld data management device for managing data (see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the Bennett's system to provide for the following: handheld data management device as this arrangement would provide another way to for interacting with remote systems as taught by Montlick.

11. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montlick in view of Ishikawa et al. (US PAT: 6,650,647, filed 9-7-1999, hereinafter Ishikawa).

Montlick differs from claim 30 in that he does not teach the following: obtaining direction to a field problem using positioning and navigation means to the handheld data management device.

However, Ishikawa discloses system, apparatus and methods for data distribution which teaches the following: obtaining direction to a field problem using positioning and navigation means to the data management device (col. 5 lines 11-32).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the Montlick's system to provide for the following: obtaining direction to a field problem using positioning and navigation means to the handheld data management device as this arrangement would facilitate the to reach the destination intended by the user for efficient arrival at the destination as taught by Ishikawa.

Art Unit: 2643

12. Claim 31-33, are rejected under 35 U.S.C. 103(a) as being unpatentable over Montlick in view of Ishikawa as applied to claim 30 above, and further in view of Brick.

Regarding claim 31, the combination does not teach the following; the program module comprises at least one of: construction industry analysis program, project management program, inventories tracking program, etc.

However, Brick discloses portable data terminal which suggests use of different program modules to satisfy application requirements (col. 1 lines 39-44).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: the program module comprises at least one of: construction industry analysis program, project management program, inventories tracking program, etc, as this arrangement would provide necessary programs to meet application requirements as suggested by Brick , thus enhancing the application capability of the system.

Regarding claims 32-33, the combination teaches the following: providing information of at least of customer identity, problem location, assessment data etc (col. 5 lines 11-32 of '647).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (703) 305-1461. The examiner can normally be reached on M-F 6:30-4:00; every other F Off.

Art Unit: 2643

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (703)305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Melur Ramakrishnaiah
Primary Examiner
Art Unit 2643